

REMARKS

The Office Action dated July 15, 2005, and made final, has been carefully reviewed and the following response has been made in consequence thereof.

Claims 1-20 are now pending in this application. Claims 1-20 stand rejected.

The undersigned wishes to express his appreciation to the Examiner for the courtesies that he extended during a telephone interview that occurred on August 18, 2005. The Examiner discussed the rationale supporting the 103 rejection. The Examiner and the undersigned both agreed that an argument may be made that the cited art does not disclose nor suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers.

The rejection of Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Fisher et al. (U.S. Patent No. 6,005,314) ("Fisher") in view of Admitted Prior Art ("APA") of Figure 1 in view of Story et al. (U.S. Patent No. 3,787,014) ("Story") and in further view of Boede et al. (U.S. Patent No. 4,933,809) ("Boede") is respectfully traversed.

Fisher describes a motor (50) that includes a housing (54) formed by a motor shell (56) and a pair of endshields (58 and 60). A stator (72) is mounted within the motor shell. The motor also includes a base (92) for support and mounting. Notably, Fisher does not describe nor suggest a motor that includes a housing body extending between an inner surface and an outer surface, wherein the body includes a plurality of raised projections that each have a thickness that is equal to a thickness of the housing body. Additionally, Fisher does not describe nor suggest a housing including a plurality of fasteners attached thereto and extending outwardly therefrom.

APA describes a motor housing (10) that includes a shell (12) having an inner surface (14) and an outer surface (16). A plurality of mounting hardware or fasteners (20) are attached i.e. welded, to the shell outer surface and extend from the shell outer surface. Fasteners (20) are spaced circumferentially around the housing and may be welded to shell

outer surface (16). Notably, APA does not describe nor suggest a motor that includes a housing body extending between an inner surface and an outer surface, wherein the body includes a plurality of raised projections that each have a thickness equal to a thickness of the housing body. Additionally, APA does not describe nor suggest a plurality of fasteners extending radially outwardly through openings in the shell.

Story describes a replacement motor mounting (50) that includes an adapter bracket (58) that includes a circular central portion and four arms. A set of fastener receiving holes (62, 64) is formed in the arms and is configured to receive a plurality of fasteners (66) extending axially from an endshield. Notably, Story does not describe nor suggest a motor that includes a housing body extending between an inner surface and an outer surface, wherein the body includes a plurality of raised projections that each have a thickness that is equal to a thickness of the housing body. Moreover, Story does not disclose openings in the endshield including raised projections extending. Additionally, Story does not describe nor suggest a motivation to prevent accidental “breaking off” of fasteners.

Boede describes a modular assembly of diverse electrical components housed in a box (10). The box is closed with a cover (47) that includes a plurality of mounting holes (56) positioned in recesses (58) and configured to receive a plurality of mounting screws (52). Notably, Boede does not describe nor suggest a motor housing configured to receive a motor wherein the housing includes a housing body extending between an inner surface and an outer surface, wherein the body includes a plurality of raised projections that each have a thickness that is equal to a thickness of the housing body. Rather, Boede describes an electrical box that includes a cover having a plurality of recesses that have a variety of thicknesses, each greater than the cover thickness. (Figure 5). Additionally, Boede does not describe nor suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers.

Claim 1 recites “a method for mounting a motor to a support, said method comprising providing a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing

including a plurality of recessed openings, an outer surface, an inner surface, a housing body extending between the inner surface and the outer surface, and a plurality of raised projections, wherein each of the projections has a thickness that is equal to a thickness of the housing body...attaching the fasteners through the openings formed in the housing, such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed portion of the inner surface of the housing and such that the head of the fasteners remain positioned between rotating components of the motor and the housing outer surface....”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a method for mounting a motor to a support as recited in Claim 1. Specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest providing a housing including a plurality of raised projections, wherein each of the projections has a thickness that is equal to a thickness of the housing body. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recesses that have a thickness greater than the cover thickness. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Fisher in view of APA, Story, and Boede.

Claims 2-4 depend from independent Claim 1. When the recitations of Claims 2-4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-4 likewise are patentable over Fisher in view of APA, Story, and Boede.

Claim 5 recites “a motor housing configured to receive a motor extending between a pair of endshields, said housing comprising...an inner surface...an outer surface...a housing

body extending between said inner surface and said outer surface, said body comprising a thickness...at least one raised projection extending radially outwardly from at least one of said housing inner surface and said housing outer surface defining a recess with respect to said housing inner surface, said projection comprising at least one opening extending therethrough, said at least one raised projection comprising an inner surface and a thickness equal to said housing body thickness....”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a housing for a motor as recited in Claim 5. Specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest at least one raised projection extending radially outwardly from at least one of a housing inner surface and a housing outer surface defining a recess with respect to a housing inner surface. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recesses that have a thickness greater than the cover thickness. For at least the reasons set forth above, Claim 5 is submitted to be patentable over Fisher in view of APA, Story, and Boede.

Claims 6-13 depend from independent Claim 5. When the recitations of Claims 6-13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-13 likewise are patentable over Fisher in view of APA, Story, and Boede.

Claim 14 recites “a motor comprising a pair of endshields...a housing extending between said endshields including at least one raised projection extending outwardly from said housing, said housing comprising an outer surface and an opposite inner surface, and a

body extending therebetween, said body comprising a thickness, said at least one raised projection defining a recess with respect to said housing inner surface and comprising an inner surface and a thickness equal to said housing body thickness, at least one opening extending through said recess, and at least one fastener having a top surface, said at least one fastener extends radially outwardly through said housing such that said top surface is substantially co-planar with said inner surface....”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motor as recited in Claim 14. Specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest at least one fastener that extends radially outwardly through a housing such that a top surface is substantially co-planar with an inner surface. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recesses that have a thickness greater than the cover thickness. For at least the reasons set forth above, Claim 14 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 15-20 depend, directly or indirectly, from independent Claim 14. When the recitations of Claims 15-20 are considered in combination with the recitations of Claim 14, Applicants submit that dependent Claims 15-20 likewise are patentable over Fisher in view of APA, Story and Boede.

Furthermore, Applicants respectfully submit that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some

motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such inferences, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 USPQ2d 1436 (Fed. Cir. 1991).

In the present case, neither a suggestion nor motivation to modify the cited art, nor any reasonable expectation of success has been shown. Examiner noted that the “Fisher in view of APA in view of Story and further in view of Boede does not teach the head of the fastener being substantially co-planar with the un-recessed portion of the inner surface of the housing.” This is an important recognition in that Fisher in view of APA in view of Story and further in view of Boede does not disclose the claimed invention. Specifically, no teaching, or suggestion has been shown to modify Fisher with APA, Story, Boede to include at least one fastener that extends radially outwardly through a housing such that a top surface is substantially co-planar with an inner surface. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, the Section 103 rejection appears to be based on a hindsight reconstruction in which several disclosures

have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-20 be withdrawn.

Furthermore, Applicants respectfully submit that Boede teaches away from the present invention. If art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Boede describes an electrical box cover that includes a plurality of recesses that have a thickness greater than the cover thickness (Figure 5). Accordingly, Applicants respectfully submit that Boede teaches away from the present invention.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103 of Claims 1-20 be withdrawn.

The rejection of Claims 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (“APA”) of Figure 1 in view of Story and in further view of Boede is respectfully traversed.

APA, Story, and Boede are described above.

Claim 5 recites “a motor housing configured to receive a motor extending between a pair of endshields, said housing comprising...an inner surface...an outer surface...a housing body extending between said inner surface and said outer surface, said body comprising a thickness...at least one raised projection extending outwardly from at least one of said housing inner surface and said housing outer surface defining a recess with respect to said housing inner surface, said projection comprising at least one opening extending therethrough, said at least one raised projection comprising an inner surface and a thickness equal to said housing body thickness....”

None of APA, Story, or Boede, considered alone or in combination, describe or suggest a housing for a motor as recited in Claim 5. Specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest at least one raised projection extending radially outwardly from at least one of a housing inner surface and a housing outer surface defining a recess with respect to a housing inner surface. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recesses that have a thickness greater than the cover thickness. For at least the reasons set forth above, Claim 5 is submitted to be patentable over APA in view of Story and Boede.

Claims 6-13 depend from independent Claim 5. When the recitations of Claims 6-13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-13 likewise are patentable over APA in view of Story and Boede.

Furthermore, Applicants respectfully submit that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such inferences, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 USPQ2d 1436 (Fed. Cir. 1991).

In the present case, neither a suggestion nor motivation to modify the cited art, nor any reasonable expectation of success has been shown. Examiner noted that the “APA in view of Story does not disclose the openings in the housing being included in raised projections extending outwardly from the housing inner surface.” This is an important recognition in that Fisher in view of APA in view of Story and further in view of Boede does not disclose the claimed invention. Specifically, no teaching, or suggestion has been shown to modify Fisher with APA, Story, Boede to include at least one fastener that extends radially outwardly through a housing such that a top surface is substantially co-planar with an inner surface. Moreover, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motivation to combine art regarding motor housings with art directed toward electrical box covers. Rather, the Section 103 rejection appears to be based on a hindsight reconstruction in which several disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 5-13 be withdrawn.

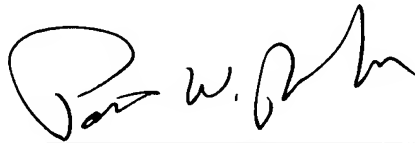
Furthermore, Applicants respectfully submit that Boede teaches away from the present invention. If art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Boede describes a box that includes a cover having a

plurality of recesses that have a thickness greater than the cover thickness. (Figure 5). Accordingly, Applicants respectfully submit that Boede teaches away from the present invention.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103 of Claims 5-13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Patrick W. Rasche", written over a horizontal line.

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